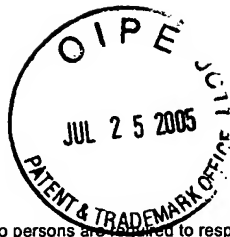


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08350-0663-00000

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Typed or printed name _____

Application Number

10/029,290

Filed

December 28, 2001

First Named Inventor

Kazunori YOSHINO

Art Unit

3745

Examiner

Frank D. Lopez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

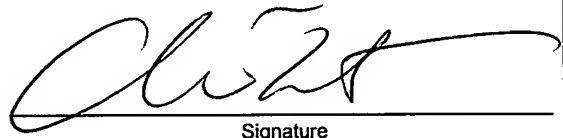
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 48,216

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Christopher T. Kent
Typed or printed name

(571) 203-2739
Telephone number

July 25, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE AFTER FINAL
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP ART UNIT 3745**

PATENT

Customer No. 22,852

Attorney Docket No. 08350.0663-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Kazunori YOSHINO) Group Art Unit: 3745
)
Application No.: 10/029,290) Examiner: Frank D. Lopez
)
Filed: December 28, 2001) Confirmation No.: 3082
)
For: HYDRAULIC CONTROL SYSTEM)
FOR REDUCING MOTOR)
CAVITATION)

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the final Office Action mailed February 23, 2005, the period for response having been extended two months by a Petition requesting an extension of time and fee payment filed concurrently herewith along with a Notice of Appeal under 37 C.F.R. § 41.31, appeal fee payment, and a completed form PTO/SB/33, Applicant respectfully requests a pre-appeal brief review of this application.

I. Rejection of Claims 1, 4, 15, and 16 under 35 U.S.C. § 103(a)

In the final Office Action, claims 1, 4, 15, and 16 were rejected under 35 U.S.C. § 103(a) based on Yoshimatsu (U.S. Patent No. 5,063,742) (hereinafter

“Yoshimatsu '742”) in combination with Krusche (U.S. Patent No. 4,665,699), and Yoshimatsu (U.S. Patent No. 5,062,266) (hereinafter “Yoshimatsu '266”). Claims 1 and 15 are the only independent claims rejected under § 103(a) based on those references, and Applicant respectfully traverses the § 103(a) rejection of independent claims 1 and 15 because the final Office Action fails to establish a case of *prima facie* obviousness for a number of reasons. First, there is no suggestion to modify the Yoshimatsu '742 reference in the rejection statement's proposed, hypothetical manner based on the Krusche reference at least because the prior art does not recognize the rejection statement's asserted functional equivalence. Second, there is no suggestion or motivation to modify the Yoshimatsu '742 reference in the rejection statement's proposed, hypothetical manner based on the Yoshimatsu '266 reference at least because the proposed modification would require changing the principle of operation of the Yoshimatsu '742 reference's disclosed system. Therefore, Applicant respectfully submits that independent claims 1 and 15 are patentably distinguishable from the Yoshimatsu '742, Krusche, and Yoshimatsu '266 references, taken individually or in combination.

A. Proposed Modification to Yoshimatsu '742 based on Krusche

In the final Office Action, the rejection statement concedes that the Yoshimatsu '742 reference does not disclose a “second flow line . . . connected to [a] motor return flow line,” but alleges that “[s]ince the connection between the pilot relief valve and the tank of Yoshimatsu (5,063,742) and Krusche are functionally equivalent; it would have been obvious . . . to connect the second flow line of Yoshimatsu (5,063,742) to the

motor return flow line, as taught by Krusche, as a matter of engineering expediency.”

Final Office Action at 3-4.

According to the guidance of the M.P.E.P., “[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” § 2144.06 (citation omitted).

Applicant respectfully submits that the prior art does not support the allegations in the final Office Action about the connection between the pilot relief valve and the tank of Yoshimatsu '742 and Krusche being allegedly “functionally equivalent.” Request for Reconsideration, May 23, 2005, at 3-4. Rather, the allegations appear to be improperly relying solely on either Applicant's disclosure or a completely unsupported “functionally equivalent” allegation. Id. Since neither of those sources is legally sufficient according to the M.P.E.P., the functional equivalence allegation lacks any credible basis. As a result, there is no legally sufficient suggestion or motivation to make the final Office Action's proposed, hypothetical modification to the Yoshimatsu '742 reference based on Krusche. Therefore, the final Office Action has failed to establish a *prima facie* case of obviousness.

B. Proposed Modification to Yoshimatsu '742 based on Yoshimatsu '266

The final Office Action also lacks any legally sufficient suggestion or motivation to make the final Office Action's proposed, hypothetical modification to Yoshimatsu '742's disclosure based on the Yoshimatsu '266 reference.

The final Office Action concedes that the Yoshimatsu '742 reference does not disclose "[a] main [pressure] relief valve [that] is a combination main relief valve and bypass valve," but asserts that "[i]t would have been obvious . . . to make the main pressure relief valve of Yoshimatsu (5,063,742) . . . a combination main relief and bypass valve . . . for the purpose of unloading the pressure source, when not needed to provide pressurized fluid." Final Office Action at 4.

The M.P.E.P. advises that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." § 2143.02 (citation omitted).

Since the Yoshimatsu '742 and Yoshimatsu '266 references do not suggest the desirability of the rejection statement's proposed, hypothetical modification to Yoshimatsu '742's disclosure, and since the proposed modification would require changing Yoshimatsu '742's principle of operation even if there were a suggestion of the desirability, the final Office Action has failed to establish a case of *prima facie* obviousness. Request for Reconsideration, May 23, 2005, at 5-7.

The Yoshimatsu '742 reference relates to a purely mechanical control system for controlling swing motion of a slewing mechanism. Id. at 6-7. In contrast, the Yoshimatsu '266 reference relates to an electrohydraulic control system including a controller 8 for controlling a slewing mechanism. Id. Therefore, making the final Office Action's proposed, hypothetical modification to the Yoshimatsu '742 reference based on the Yoshimatsu '266 reference would require changing the Yoshimatsu '742 reference's principle of operation. Id. at 7-8. For at least this reason, independent claims 1 and 15

are patentably distinguishable from the Yoshimatsu '742, Krusche, and Yoshimatsu '266 references, taken individually or in combination.

II. Conclusion

For at least the reasons set forth above, independent claims 1 and 15 should be allowable. Dependent claims 4, 5, 7, 9, 10, 12-14, 16, and 21 depend from one of independent claims 1 and 15. Consequently, those dependent claims should be allowable for at least the same reasons their corresponding independent claim is allowable.

Therefore, Applicant respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1, 4, 5, 7, 9, 10, 12-16, and 21.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Christopher T. Kent
Reg. No. 48,216

Dated: July 25, 2005